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EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,488

Applicant(s)

HOFFMAN, ROGER P.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-8, 11, and 14-22 have been examined.

Claim Objections

Claims 1-7, 19, 20, and 21

Claims 1-7, 19, 20, and 21 are objected to because of the following informalities:

In the fifth line of claim 1, "said request for quotation" lacks proper antecedent basis; also, "selecting suppliers to submit said request for quotation" should be something like "selecting suppliers to whom to submit said request for quotation", because the suppliers are receiving rather than submitting RFQ's. Appropriate correction is required.

Claim 2 is objected to because of the following informalities: The limitation, "said quotation is submitted to said suppliers via a wireless method," (which incidentally, corresponds to the language at the top of page 2 of the specification) should presumably be "said **request for** quotation is submitted to said suppliers via a wireless method." Appropriate correction is required.

Claim 3 is objected to because of the following informalities: In the first line of claim 3, "said supplier" lacks antecedent basis, as claim 1 refers to suppliers (plural). Examiner requests clarification, such as reciting "at least one of said suppliers" or "each of said suppliers". Appropriate correction is required.

Claims 4, 5, and 7 are objected to because of the following informalities: In the first line of claim 4, "said supplier" lacks antecedent basis, as claim 1 refers to suppliers (plural). Claims 5 and 7 also recite "said supplier". Examiner requests clarification,

such as reciting “at least one of said suppliers” or “each of said suppliers”. Appropriate correction is required.

Claim 6 is objected to because of the following informalities: In the first line of claim 6, “said quotation” lacks antecedent basis. Appropriate correction is required.

Claim 7 is objected to because of the following informalities: In the first line of claim 7, the semicolon after “comprising” should be a colon. In the second line of claim 7, “said quotation from said supplier” has questionable antecedent basis, as claim 4 refers to a supplier providing a response (not specified as being a quotation). Appropriate correction is required.

Claims 19, 20, and 21 are objected to because of the following informalities: In the first line of each of these claims, the semicolon after “comprising” should be a colon. Appropriate correction is required.

Claim 21 is objected to because of the following informalities: In the second line of claim 21, “said quote from said supplier” lacks antecedent basis, as claim 1 refers to suppliers (plural), and refers to requesting a quotation (presumed to be the same as a quote), but does not expressly recite receiving a quote from a particular supplier. Examiner requests clarification, such as reciting “at least one of said suppliers” or “each of said suppliers”. Appropriate correction is required.

Claims 8, 11, 14-18, and 22

Claims 8, 11, 14-18 and 22 are objected to because of the following informalities: In the second line of claim 8, the semicolon after “comprising” should be a colon. In the

seventh line of claim 8, "delivering said quotation form" should be "delivering said request for quotation form". Appropriate correction is required.

Claims 15, 16, 17, and 18 are objected to because of the following informalities:
In the first line of each of these claims, the semicolon after "comprising" should be a colon. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 19, 20, and 21 are rejected under 35 U.S.C. 101 because the claims are directed to a method not within the technological arts ("technological arts" being considered equivalent to "useful arts," mentioned in Article I, Section 8 of the United States Constitution, saying that Congress shall have "power to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writing and Discoveries" – see *In re Musgrave*, 431 F.2d 882, 167 USPQ [CCPA 1970]). The claims are directed to a method that does nothing more than manipulate an abstract idea. To be patentable, a method claim must produce a useful, concrete, and tangible result, or involve a step or act of manipulating technology (see *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ 2d. at 1452). The recited method for a buyer to request a quotation may be, in a sense, useful, but is not concrete or tangible, and need not involve a step or act of manipulating technology.

Although claim 1 recites a database, a database need not necessarily be an electronic database, and neither claim 1 nor any of its dependents recites computer-implemented or other technological manipulation of the database in carrying out the steps of inputting various data, selecting suppliers, and submitting a request for quotation.

Claim 8 and its dependents are **not** rejected as non-statutory under 35 U.S.C. 101. Although the system recited in claim 8 need not inherently involve technology, or at least need not inherently involve non-trivial use of technology, the means plus function language ("means for delivering") is held to invoke 35 U.S.C. 112, sixth paragraph: "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Because the specification of the instant application discloses technological implementations of the claimed invention as preferred embodiments, and nowhere expressly discloses a purely non-technological implementation, claim 8 and its dependents are construed to cover the corresponding structure, etc., described in the specification, and therefore to be within the technological arts.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The specification and original claims do not indicate that the system provides product specifications of each seller to the buyer, still less that the buyer determines what product specifications are missing.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 4, 7, 20, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Baatz ("An Auction with the Buyer Completely in Charge"). As per claim 1, Baatz discloses a method for a buyer to request a quotation, the method comprising: inputting or choosing attributes of a specific product into a database (second and third columns on page S58); inputting the quantity of product (ibid., and first column on S61); inputting delivery specifications (second column on page S58); selecting suppliers to whom to submit the request for quotation (third column on S58); and submitting said

request for quotation to said suppliers (third column on S58). Baatz is not explicit about the database as such, but the disclosure of the retention and availability of information inherently requires a database of some sort.

As per claim 4, Baatz discloses selected suppliers providing responses to the buyer (third column on page S58).

As per claim 7, Baatz discloses comparing the quotation from one supplier to quotations from other suppliers (note "three lowest bidders" in the third column on page S58).

As per claim 20, Baatz discloses rating quotes from the suppliers (note "three lowest bidders" in the third column on page S58, which implies rating which are lowest).

As per claim 21, Baatz discloses submitting quote from suppliers to a broker (Sorcity being a broker; third column on page S58).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6, and 19

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz as applied to claim 1 above, and further in view of official notice. Baatz does not disclose that the quotation (or request for quotation) is submitted to the suppliers via a wireless

method, but official notice is taken that it is well known for information to be transmitted via wireless methods (e.g., to and from cell phones, microwave transmission of Internet data, etc.). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the request for quotation to be submitted to the suppliers via a wireless method, for the obvious advantage of making the request for quotation readily available to suppliers in contact with a communications network at least in part via wireless means.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz as applied to claim 1 above, and further in view of Breen, Jr., et al. (U.S. Patent 6,598,027). Baatz does not disclose the supplier analyzing said quotation with a logistics database to provide freight quotes, but Breen teaches a database accessible to a supplier for providing freight quotes to suppliers and buyers (column 7, lines 19-64; column 10, lines 37-39). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the supplier to analyze said quotation with a logistics database to provide freight quotes, for the obvious advantage of enabling the supplier to set appropriate bids including freight costs.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz as applied to claim 4 above, and further in view of official notice. Claim 5 is held to be obvious for essentially the reasons set forth above regarding claim 2.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz as applied to claim 1 above, and further in view of Ojha et al. (U.S. Patent 6,598,026).

Baatz discloses the buyer specifying a time limit for bidding (third column of S58), but does not disclose that the supplier's quotation has an expiration mechanism. However, Ojha teaches a supplier's quotation having an expiration mechanism (column 15, line 1, through column 16, line 4). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the quotation to have an expiration mechanism, for the obvious advantage of enabling a supplier to quote a price without being bound to it if circumstances change (e.g., prices go up, or manufacturing equipment is committed to other purposes).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz as applied to claim 1 above, and further in view of official notice. Baatz does not disclose copying agreed upon terms into a purchase order, but Baatz does teach carrying out a purchase after a supplier has submitted terms, and been accepted by the buyer (third column of S58; page S61); and official notice is taken that it is well known to copy information. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to copy agreed upon terms into a purchase order, for the obvious advantage of arranging and documenting a purchase according to agreed upon terms, without the trouble of rewriting the same information.

Claims 8, 11, 14-18, and 22

Claims 8, 15-18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz ("An Auction with the Buyer Completely in Charge") in view of official notice. As per claim 8, Baatz discloses a system for a buyer to request a quotation, the system comprising: a request for quotation form (second column on page

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S58); and a means for delivering said request for quotation form to a seller (second and third columns on page S58). Baatz discloses storing quotations from sellers; and allowing the buyer to compare said quotations (second and third columns on page S58). Baatz is not explicit about the system comprising a database as such, but the disclosure of the retention and availability of information inherently requires at least one database of some sort. Baatz does not expressly disclose that said request for quotation form comprises a list of product specifications, but does disclose that, "The item as well as payment and delivery terms must be specified precisely," and discloses "a form online with detailed questions for the buyer to answer about the RFQ." Official notice is taken that lists are well known for specifying pluralities of details. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the form to comprise such a list, for the obvious advantage of making the various specifications conveniently available to potential sellers.

As per claim 15, Baatz does not disclose a system for performing a credit check of a buyer (although Baatz does disclose asking for detailed information about buyers, first column of page S58), but official notice is taken that performing credit checks on buyers is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include such a system, for the obvious advantage of not selling valuable items to insolvent or untrustworthy purchasers.

As per claim 16, Baatz does not disclose a database of buyer credit profiles (although Baatz does disclose asking for detailed information about buyers, first column

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of page S58), but official notice is taken that maintaining such buyer credit profiles is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include a database of buyer credit profiles in the system, for the obvious advantage of judging the creditworthiness of buyers, and not selling valuable items to insolvent or untrustworthy purchasers.

As per claim 17, Baatz does not disclose a database comprising a listing of previous sales, but official notice is taken that it is well known to maintain records of previous sales. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the system to comprise a database comprising a listing of previous sales, for such obvious advantages as checking sellers' records of delivering products as advertised and on schedule, and buyers' records of paying as promised.

As per claim 18, Baatz does not disclose a searchable database of buyer/seller quote history, but does disclose that buyers can watch the bidding process (third column on page S58), showing that a quote history is maintained to some degree; and official notice is taken that searchable databases are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the system to include a searchable database of buyer/seller quote history, for such obvious advantages as resolving any disputes that may arise on bidding, and analyzing the operations of the system with a view toward improvements.

As per claim 22, Baatz does not expressly disclose that the system provides product specifications of each seller to said buyer to determine what specifications are

missing, but Baatz does disclose the system providing means for buyer and sellers to exchange information (third column on page S58), and official notice is taken that it is well known for sellers of products to provide specifications of their systems. (It is noted that claim 22 only recites, "the system can provide," rather than "the system provides," and that "to determine" is merely a statement of intended purpose.) Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the system to be able to provide product specifications of each seller to said buyer to determine what specifications were missing, for the obvious advantage of enabling buyers to judge sellers' products' fitness for their purposes.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz and official notice as applied to claim 8 above, and further in view of Breen, Jr., et al. (U.S. Patent 6,598,027). Claim 11 is essentially parallel to claim 3, and rejected on the same grounds set forth above in rejecting claim 3.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baatz and official notice as applied to claim 8 above, and further in view of the article, "Robertson, Stephens Founder Sanford R. 'Sandy' Robertson Invests in LIMITrader Securities; Takes Stake in New York Firm Pioneering Electronic Bond Trading," hereinafter "Robertson". Baatz does not disclose that the system comprises a secured chat room, but "Robertson" teaches a trading system including a secure chat room for the buyer and seller to negotiate in (paragraph beginning "LIMITrader.com's online bond trading solution"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include a secured chat

room, for the stated advantage of facilitating negotiations between the buyer and the seller.

Response to Arguments

Applicant's arguments filed January 5, 2004, have been fully considered but they are not persuasive. Applicant argues that claim 1 requires that the buyer select suppliers. Examiner replies that claim 1 does not expressly recite this, but merely "selecting suppliers," which might be done by a buyer or an intermediary. In examining claims, it is proper to give them their broadest reasonable interpretation. Similarly, claim 7 only recites "comparing said quotation" without specifying who does the comparing, does not specify that the comparison is made on the basis of elements other than price; therefore, contrary to Applicant's argument, the claim language of claim 7 is held not to distinguish over the Sorcity system described by Baatz.

Regarding claims 2 and 5, Applicant writes, "Sorcity chose to apply e-mail, but it would have been obvious to utilize any available messaging service whether e-mail, telephone, or wireless-message-based," which is essentially Examiner's view. Therefore, Applicant's statements, although true in themselves, that Sorcity does not disclose the use of a wireless system, are insufficient to make claims 2 and 5 allowable, since these claims were rejected as obvious rather than anticipated. Similarly, Applicant's statements regarding the obviousness of the limitations of claims 3, 11, 15, and 16 do not contribute very well to supporting the assertion that these claims are not

obvious over the Sorcity system described by Baatz (it is agreed that they are not anticipated).

Applicant's arguments with respect to claim 14 have been considered but are moot in view of the new ground(s) of rejection. Examiner has added and relied upon the "Robertson" reference, as set forth in the rejections above.

The MetalSite website is no longer relied upon in rejecting claims 17 and 18; Examiner has taken official notice, and is prepared to document his assertion of the well-known character of the recited limitations, if necessary. Examiner does wish to comment, however, that Applicant's argument, "Sorcity is a reverse auction system and therefore would not be combined with MetalSite which is an RFQ system," is unpersuasive, in part because Sorcity *is* an RFQ system, and the Baatz article repeatedly uses the term RFQ in describing Sorcity.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mandler et al. (U.S. Patent 5,732,400) disclose a system and method for a risk-based purchase of goods. Patterson, Jr. et al. (U.S. Patent 5,915,245) disclose a two-way wireless system for financial industry transactions. Callen (U.S. Patent 6,556,976) discloses a method and system for e-commerce and related data management, analysis, and reporting. Kinney, Jr. et al. (U.S. Patent 6,564,192) disclose a method and system for differential index bidding in online auctions.

Koopersmith (U.S. Patent Application Publication 2001/0042002) discloses a method and system for communicating targeted information. Beran et al. (U.S. Patent Application Publication 2002/0055888) disclose an Internet-based commerce system. De La Motte et al. (U.S. Patent Application Publication 2003/0014318) disclose an international trading system and method.

Roughgarden et al. (WO 93/24892 A1) disclose methods and apparatus for quote processing.

Cohen ("International Language") discloses a multilingual chat server wherein business users can secure chat rooms with a password.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner's telephone number is expected to change to 571-272-6762 on or about April 13, 2005. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

March 8, 2005